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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,039	10/15/2003	Erich Kast	BE-118	6415

7590 04/05/2005
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EXAMINER

COMSTOCK, DAVID C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,039

Applicant(s)

KAST ET AL.

Examiner

David Comstock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4 and 7-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION***Claim Objections***

Claims 7-10 are objected to because of the following informalities: Claims 7-10 depend from claim 6, which has been canceled. Therefore, it is unclear what subject matter is included within the scope of these claims. For examination purposes, and as best understood, claims 7, 8 and 10 will be treated as depending from claim 1 (claim 9 depends from claim 8). Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Vaccaro (6,102,950).

Vaccaro discloses an intervertebral implant 10 for placement between vertebrae (see Figs. 1, 2, 6 and 7). The implant comprises two sidepieces 22,24 joined together at one end 60 and that are free at the opposite end. A slider device 40 vertically distracts the sidepieces. The slider moves in pure translation. The slider rests against the sidepieces over an entire horizontal width thereof. The sidepieces are formed from a single piece of resilient

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material. Outside and inside surfaces, e.g. 50b, of the sidepieces are configured to converge toward the free end of the sidepieces in an initial position for distraction (see, e.g., Fig. 6). The slider 40 releasably locks into a desired position, by a threaded arrangement 30,34. The slider is flush with the outer side surfaces of the device and also with the end surfaces thereof, when the slider device 40 is fully inserted between the sidepieces. The device is capable of being placed in a lateral half-space between two vertebrae. It is noted that the size of the vertebrae (or the species of the animal in which the device is to be implanted) has not been specified in the claims. The implant has an oblong--i.e. having the shape of or resembling a rectangle or an ellipse--vertical opening 26.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaccaro (6,102,950) in view of Baccelli et al. (2003/0028249).

Vaccaro discloses the claimed invention except for explicitly reciting that the device can be formed of a plastic such as polyetheretherketone (PEEK).

Baccelli et al. disclose an implant 2 formed from PEEK in order to be transparent to X-rays and facilitate inspection of the implant (see Fig. 1 and par. 50). It would

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have been obvious to a person of ordinary skill in the art at the time of the invention to form the implant of Vaccaro from PEEK, in view of Baccelli et al., in order to be transparent to X-rays and to facilitate inspection of the implant.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vaccaro (6,102,950) in view of Michelson (5,522,899).

Vaccaro discloses the claimed invention except for an opening opposite the free end of the device. Michelson discloses an implant device, also for spinal fusion, comprising openings 324 all over the device, including on its ends, in order to promote bony ingrowth and ensure the permanency of the result (see Michelson, e.g., Fig. 15; col. 1, lines 12-23; and col. 10, lines 20-21). It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide the implant of Vaccaro with an opening opposite the free end of the device, in view of Michelson, in order to promote bony ingrowth and ensure the permanency of the result. It is noted that such a hole is at least capable of admitting therethrough a tool such as a pick or pusher rod.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. It is noted that amended claim 1 includes

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limitations not present in canceled claims 5 and 6. Specifically, in addition to the limitations of claims 5 and 6, claim 1 now also requires exclusive translatory motion and that the slider rests against the sidepieces along an entire horizontal width thereof. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock
03 April 2005



EDUARDO C. ROBERT
PRIMARY EXAMINER